2834

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Application Number	09/680,345
Filing Date	10/05/2000
First Named Inventor	David W. Baarman
Art Unit	2834
Examiner Name	Pedro J. Cuevas
Total Number of Pages in This Submission: 5	Attorney Docket Number: 3086/1230 (BH 2068)

ENCLOSURES (*Check all that apply*)

- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment/Reply
- ☒ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
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- ☐ After Allowance Communication to a Technology Center (TC)
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
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Remarks

Response to Office Action Following Filing of Appeal Brief

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Sanders N. Hillis (Registration No. 45,712)
Signature	
Date	July 2, 2003

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Typed or printed	Barbara A. LaBarge		
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Barbara A. LaBarge

PATENT
Case No.: 3086/1230 (BH 2068)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
)
David W. Baarman, et al.)
)
Serial No.: 09/680,345)
)
Filed: October 5, 2000)
)
For: HYDRO-POWER GENERATION)
FOR A WATER TREATMENT SYSTEM)

Group Art Unit: 2834

Examiner: Pedro J. Cuevas

RESPONSE TO OFFICE ACTION FOLLOWING FILING OF APPEAL BRIEF

The Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Washington, DC 20231

Dear Sir:

In response to the Office action mailed June 4, 2003, please consider the following remarks.

REMARKS

Claims 1, 3-18, 29, 32-41, 53-56 and 58-59 remain pending and are the subject of the pending appeal. The appeal brief was filed on April 21, 2003 via first class mail.

Defective Appeal Brief

The Examiner has objected to the declaration of Mr. Karlis Vecziedins because the declaration was not considered by the Examiner during the prosecution of the case. In addition, the Examiner has asserted that the declaration brings new issues not previously

present. The Examiner further objected to the declaration on the grounds that the declaration only refers to the system and not the individual claims of the application.

Declaration Not Filed Prior To Appeal

Pursuant to 37 CFR §1.195 a declaration submitted after the case has been appealed will not be admitted without showing of a good and sufficient reason why the declaration was not earlier presented. Applicants amended claims 14-15 and 38 in a First Office Action Response mailed on June 17, 2002. Applicants received a final office action mailed on October 17, 2002 in which the Examiner for the first time rejected amended claims 14-15 and claims 38-40 pursuant to 37 CFR § 103(a) in view of US Patent 4,731,545 to Lerner (hereinafter referred to as "Lerner") and further in view of common knowledge in the art. Pursuant to MPEP § 2144.03, Applicants seasonable challenged the Examiner's reliance on common knowledge in the art in an After Final Office Action Response mailed on December 13, 2002 and cited MPEP § 2144.03. In addition, the Applicants specifically requested the Examiner to provide evidence supporting his assertion that the claimed invention was common knowledge in the art. "If the applicant traverses such an assertion [an assertion of common knowledge in the art] the examiner should cite a reference in support of his or her position." MPEP § 2144.03.

In response to the Applicants' After Final Office Action Response the Examiner issued an Advisory Action mailed January 15, 2003 indicating only that Applicants' arguments were not persuasive. The Advisory Action was received by the Applicants after expiration of the three month period for response. Applicants fully expected the Examiner to provide supporting evidence in accordance with MPEP § 2144.03 when seasonably challenge. Applicants further knew that such evidence was not available and therefore expected the Examiner to reconsider his rejection of amended claims 14-15 and 38-40. Applicants only had sufficient reason to submit the Declaration of Mr. Karlis Vecziedins after the provisions of MPEP § 2144.03 had been ignored. Further, Applicants had sufficient reasons to avoid the expense of the formulation of a second after final response and the associated extension of time

fees in view of the Examiner's apparent unwillingness to comply with the provisions of MPEP § 2144.03.

Declaration Brings New Issues Not Previously Presented

As indicated in the After Final Office Action Response mailed on December 13, 2002 and part G of the Appeal Brief, one of the issues on appeal is whether claims 14-15 and 38-40 are obvious pursuant to 37 CFR § 103(a) in view of Lerner and further in view of common knowledge in the art. The Declaration squarely addresses this issue and Applicant is unable to determine how new issues are raised. In fact, the issues discussed by the Declaration of Mr. Karlis Vecziedins are centered around the claim limitations of claims 14-15 and 38-40.

Declarations Only Discusses System Not Claims

As indicated in the Appeal Brief, the Declaration of Mr. Karlis Vecziedins was submitted in support of Group V (claims 14-15 and 38-40). The claim limitations set forth in claims 14-15 and 38-40 are discussed in detail by Mr. Karlis Vecziedins at point 5(d), 5(e), 5(f) and in the conclusion of his Declaration. In fact, discussion of the subject matter of claims 14-15 and 38-40 represents the bulk of Mr. Vecziedins statements and conclusions regarding the state of the art and common knowledge in the art.

The 35 U.S.C. 103(a) Rejection of Claims 14-15 and 38-40

The Examiner has asserted that the Declaration of Mr. Karlis Vecziedins is insufficient to overcome the rejection of claims 14-15 and 38-40. To establish a *prima facie* case of obviousness, one requirement is that the prior art references must teach or suggest all the claim limitations. MPEP § 706.02(j). The Examiner has failed to produce any reference that teaches or suggests the limitations disclosed by claims 14-15 and claims 38-40. In addition, the Declaration of Mr. Karlis Vecziedins directly rebuts the Examiners assertions of common knowledge in the art. Accordingly, the Examiner has not established a prima facie case of obviousness. The Examiner is respectfully reminded that it is impermissible to use the Applicants' own disclosure as a teaching or suggestion of the obviousness of a combination.

To imbue one of ordinary skill in the art with the knowledge of the invention in suit , when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983). Cf., Ruiz v. A.B. Chance Co., 57 U.S.P.Q.2nd 1161, 1166 (Fed. Cir. 2000).

No fees are believed to be required at this time. However, should any fees be deemed necessary, please charge such fees to Deposit Account No. 23-1925. Should the Examiner deem a telephone conference to be beneficial, the Examiner is invited to call the undersigned attorney at the telephone number listed below

Respectfully submitted,

Sanders N. Hillis
Attorney Reg. No. 45,712

SNH/bal

BRINKS HOFER GILSON & LIONE
One Indiana Square, Suite 1600
Indianapolis, Indiana 46204
Telephone: 317-636-0886
Facsimile: 317-634-6701